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In re Application of
KELLY et al.
U.S. Application No. 09/787,602
PCT No.: PCT/US99/21666
Int. Filing Date: 20 September 1999
Priority Date: 21 September 1998
Attorney Docket No.: MOT-D2191
For: METHOD AND APPARATUS FOR
SHUFFLING AND DESHUFFLING
VIDEO SIGNALS

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(a)" filed 27 August 2001 to accept the application without the signature of joint inventor, Charles P. Kelly. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 20 September 1999, applicants filed international application PCT/US99/21666 which claimed a priority date of 21 September 1998 and which designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 21 March 2001.

On 21 March 2001, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); international application; and an international preliminary examination report.

On 24 April 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 27 August 2001, applicants filed: "Communication in Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office"; a declarations and power of attorneys signed by one of the to joint inventors; a petition under 37 CFR 1.47(a) and the requisite fee; and a two-month extension and the requisite fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

As to item (2), petitioner states that Charles P. Kelly has refused to sign the application papers. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in

support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Charles P. Kelly. Petitioner states, "[o]n May 1, 2001, Mr. Kelly was sent a letter via FedEx by the undersigned requesting that Mr. Kelly review and sign a Declaration and Power of Attorney and Assignment." Additionally, Mr. Kelly was sent via FedEx a Declaration/Power of Attorney and Assignment on May 16, 2001; June 4, 2001; June 19, 2001; July 2, 2001; and July 12, 2001. The mailing of the Declaration/Power of Attorney and Assignment is not considered a complete copy of the application papers (specification, including claims, drawings, and oath or declaration).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Charles P. Kelly under 37 CFR 1.47(a) at this time.

CONCLUSION

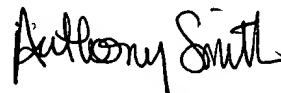
The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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